

The opinion in support of the decision being entered
today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MAREK Z. KUBIN and RAYMOND G. GOODWIN

Appeal 2007-0819
Application 09/667,859
Technology Center 1600

Decided: October 24, 2007

Before MICHAEL R. FLEMING, *Chief Administrative Patent Judge*,
TEDDY S. GRON, TONI R. SCHEINER, ERIC GRIMES, and
NANCY J. LINCK, *Administrative Patent Judges*.

LINCK, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Pursuant to 37 C.F.R. § 41.52, Appellants request rehearing and reversal of the Board's May 31, 2007 Decision on Appeal ("Decision")¹ with respect to the Board's obviousness and written description determinations (Request for Rehearing Pursuant to 37 C.F.R. § 41.52

¹ The Decision has been designated "Precedential."

(“Request”). We have reconsidered the decision pursuant to 35 U.S.C. § 6(b) and 37 C.F.R. § 41.52 on the points specifically raised in the request; and

DENY the requested relief.

DISCUSSION

Appellants argue five points on which they believe rehearing should be granted. According to Appellants, our Decision —

1. is inconsistent with *Takeda Chem. Indus. v. Alphapharm Pty., Ltd.*, 492 F.3d 1350 (Fed. Cir. 2007);
2. “overlooked or misapprehended the state of the prior art,” “misapprehended” Mathew’s teachings, and “incorrectly dismissed the compelling ‘teaching away’ evidence of Mathew”;
3. inappropriately failed to enter a new ground of rejection, if the Decision did not rely on Mathew and instead was based solely on Valiente and Sambrook;
4. “erroneously stated that Appellants did not separately argue the claims”; and
5. “overlooked or misapprehended . . . the state of the art,” as to the written description rejection (Request 1-4).

We have carefully considered Appellants’ arguments and conclude they have not established that the Board’s Decision should be modified.

Takeda was decided after our Decision. Moreover, *Takeda* is factually dissimilar, and, in any case, does not take any position contrary to those expressed in the Board’s Decision.

Second, Appellants have not shown that the Board overlooked or misapprehended the state of the prior art or Mathew's teachings in any significant regard. The relevant art, including Mathew, was carefully analyzed, and appropriate factual findings² were made (Decision 4-7 (FF 1-18)).

Third, Appellants have not shown that the Board was required to enter a new ground of rejection. The Board found Mathew's teachings were cumulative (*id.* at 5 (FF 8)). The rejection remains under § 103(a), based on the same references relied upon by the Examiner. Appellants had a full and fair opportunity to respond to the Valiente and Sambrook teachings. *See In re Kronig*, 539 F.2d 1300, 1302 (CCPA 1976) ("the ultimate criterion of whether a rejection is considered 'new' in a decision by the board is whether appellants have had fair opportunity to react to the thrust of the rejection").

Fourth, Appellants have not shown the Board erred in finding that the claims were not argued separately, pursuant to 37 C.F.R. § 41.37(c)(1)(vii). "A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim." *Id.* Arguments such as the "remainder of the Claims have separate and distinct limitations and must be considered independently" (Appeal Br.³ 5) do not meet the requirements of the Rules. Appellants have not established that language such as "[t]he cited references, alone or in combination, fail to teach a single nucleic acid molecule encoding a polypeptide at least 80% or 90% identical to SEQ ID NO:2 as required by Claims 73, 74, and 84-89, much less the specific nucleic acid sequences specified in the remainder of

² Findings of Fact are abbreviated "FF."

³ Appellants' Brief (filed Sept. 24, 2003).

the claims" (Appeal Br. 18) and "the Office failed to present any evidence that the cited references teach the 80% identity limitation of Claims 73, 80 and 84-89, the 90% identity limitation of Claim 74, or the specific sequences [of] Claims 75-78 and 81-83" (*id.* at 20) supports Appellants' position. The Board fairly exercised its discretion in selecting claim 73 as representative (*see* 37 C.F.R. § 41.37(c)(1)(vii)).

Finally, Appellants have not shown that the Board overlooked or misapprehended the state of the prior art with respect to the written description rejection (*see* Decision 12-14 (FF 19-30) & 13-17 (reasoning supporting the Board's finding that "Appellants did not describe the invention of claim 73 sufficiently to show they had possession of the claimed genus of nucleic acids" (*id.* at 15))).

CONCLUSION

The request for rehearing has been considered, but relief on the merits is—

DENIED

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